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REMARKS

Claims 1-33 are currently pending in the subject application and are presently under consideration. Claims 1, 11, 20, 28-30, 32, and 33 have been amended as shown at pp. 1-7 of this Reply.

It is respectfully submitted that the original oath or declaration as filed *was not* defective as indicated by the Examiner. Specifically, the filed declaration on page 1 recited the applicant's duty to disclose as "***I acknowledge*** the duty to disclose information which is material to patentability in accordance with Title 37, Code of Federal regulations §1.56(a)." Paragraph (a) of section 37 C.F.R §1.56 clearly states that "Each individual associated with the filing and prosecution of a patent application has a duty of candor and good faith in dealing with the Office, which includes a duty to disclose to the Office all information known to that individual to be material to patentability *as defined in this section.*" Consequently, an oath or declaration to Paragraph (a) of section 37 C.F.R §1.56 results in an oath or declaration to all paragraphs of section of 37 C.F.R §1.56. Since the applicant properly executed the declaration in accordance with the above language, this affirms that the person making the oath or declaration has acknowledged such duty in view of the language referring to *I acknowledge...* at page 1 of the originally submitted declaration.

Favorable reconsideration of the subject patent application is respectfully requested in view of the comments and amendments herein.

**I. Rejection of Claim 35 Under 35 U.S.C. §112**

Claim 35 stands rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 35 has been amended herein to correct any deficiencies related to this rejection. Accordingly, withdrawal of this rejection is respectfully requested.

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**III. Rejection of Claims 20-22 and 27-29 Under 35 U.S.C. §102(e)**

Claims 20-23 and 27-29 stand rejected under 35 U.S.C. §102(e) as being anticipated by Goodwin, *et al.* (U.S. 6,158,049). It is respectfully submitted that this rejection should be withdrawn for at least the following reasons. Goodwin, *et al.* does not teach each and every element of applicant's invention as recited in the subject claims.

A single prior art reference anticipates a patent claim only if it expressly or inherently describes each and every limitation set forth in the patent claim. *Trintec Industries, Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 63 U.S.P.Q.2D 1597 (Fed. Cir. 2002); *See Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the ... claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

The subject invention relates to loading an appropriate executable image at run time in a virtual execution environment based upon attributes associated with the operating environment of the virtual execution environment. For example, the attributes can related to a specific user that is running applications in the operating environment, thus allowing for the subject invention to create one or more executable images that are optimized for the user's current needs. In particular, independent claim 20 (and similarly independent claim 28) recites *generating runtime feedback associated with the first code image to adjust a subsequent code image according to the runtime environment, the feedback includes at least a set of information to create a code image according to a particular user.*

Goodwin, *et al.* does not teach or suggest the aforementioned novel features of applicant's claimed invention as recited in the subject claims. Rather, Goodwin *et al.* discloses a system whereby code is inserted into an original image as "instrumentation" code and the original image plus the instrumentation code is run to determine a profile that can later be used to generate an optimized version of the original code. The cited art is concerned with automating the process of optimizing native machine code that is generated from high-level language compilers. Goodwin, *et al.* is silent regarding any

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code image runtime feedback related to a particular user. Therefore, Goodwin, *et al.* fails to teach or suggest generating runtime feedback associated with the first code image to adjust a subsequent code image according to the runtime environment, the feedback includes at least a set of information to create a code image according to a particular user.

In view of at least the foregoing discussion, applicant's representative respectfully submits that Goodwin, *et al.* fails to teach or suggest all limitations of applicant's invention as recited in independent claims 20 and 28 (and claims 22, 23, 27 and 29 that respectfully depend there from), and thus fails to anticipate the subject claimed invention. Accordingly, this rejection should be withdrawn.

**IV. Rejection of Claims 1, 2, 5-10, 12-17, 19, 30, and 31 Under 35 U.S.C. §103(a)**

Claims 1, 2, 5-10, 12-17, 19, 30, and 31 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Breslau, *et al.* (U.S. 5,761,512) in view of Spyker, *et al.* (U.S. 6,571,389). It is respectfully submitted that this rejection should be withdrawn for at least the following reasons. Breslau, *et al.* and Spyker, *et al.*, alone or in combination, do not teach or suggest each and every limitation of applicant's claimed invention.

To reject claims in an application under §103, an examiner must establish a *prima facie* case of obviousness. A *prima facie* case of obviousness is established by a showing of three basic criteria. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See MPEP §706.02(j). The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. See *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Independent claim 1 (and similarly independent claim 30) has been amended to recite a log to store information relating to the operating environment of the virtual subsystem, the logged information includes at least a set of information to create a

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*native executable according to a particular user, the logged information is employed as feedback to generate a native executable based upon the availability of the specialized image. Breslau, et al. and Spyker, et al. fail to teach or suggest this limitation as conceded in the Office Action discussion of claim 11, from which this limitation was extracted. Accordingly, this rejection should be withdrawn.*

**V. Rejection of Claims 3 and 4 Under 35 U.S.C. §103(a)**

Claims 3 and 4 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Breslau *et al.* (U.S. 5,761,512) in view of Spyker *et al.* (U.S. 6,571,389) and further in view of Fogarty, *et al.* (U.S. Patent Number 6,721,946). It is respectfully submitted that this rejection should be withdrawn for at least the following reasons. Fogarty *et al.* does not make up for the aforementioned deficiencies noted above with respect to Breslau, *et al.* and Spyker *et al.* regarding amended independent claim 1, from which the subject claims depend. The cited art is related to manufacturing of build to order computers and assessing options configurations that are frequently purchased to produce static installation images. Notably, Fogarty *et al.* fails to teach or suggest a system that contains *a log to store information relating to the operating environment of the virtual subsystem, the logged information includes at least a set of information to create a native executable according to a particular user* as recited in amended claim 1. Therefore, it is respectfully submitted that this rejection be withdrawn.

**VI. Rejection of Claim 11 Under 35 U.S.C. §103(a)**

Claim 11 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Breslau *et al.* in view of Spyker *et al.* and further in view of Cooligan *et al.* (U.S. 6,519,762). It is respectfully submitted that this rejection should be withdrawn for at least the following reasons. Cooligan *et al.* does not make up for the above noted deficiencies with respect to Breslau *et al.* and Spyker *et al.* regarding amended independent claim 1, from which the subject claim depends. Contrary to assertions in the Office Action, the cited art does not teach or suggest a system that contains *a log to store information relating to the operating environment of the virtual subsystem, the logged information including at least a set of information to create a native executable according to a particular user.* The section of the

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prior art referenced in the Office Action relates to installation of software by a user on a build-to-order system and merely reflects that a user may perform customization of programs during the installation. Cooligan *et al.* is silent regarding logging any runtime user information to produce an executable image. Accordingly, this rejection should be withdrawn.

**VII. Rejection of Claim 18 Under 35 U.S.C. §103(a)**

Claim 18 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Breslau *et al.* in view of Spyker *et al.* and further in view of Nelin *et al.* (U.S. 6,253,368). It is respectfully submitted that this rejection should be withdrawn for at least the following reasons. Nelin *et al.* does not make up for the above noted deficiencies with respect to Breslau *et al.* and Spyker *et al.* regarding amended independent claim 1, from which the subject claim depends. Nelin *et al.* discloses a system related to dynamically debugging internet applications. Nelin *et al.* fails to teach or suggest a system that contains *a log to store information relating to the operating environment of the virtual subsystem, the logged information including at least a set of information to create a native executable according to a particular user* as recited in amended claim 1. Therefore, it is respectfully submitted that this rejection should be withdrawn.

**VIII. Rejection of Claims 24-26 Under 35 U.S.C. §103(a)**

Claims 24-26 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Goodwin *et al.* (U.S. 6,158,049) in view of Breslau *et al.* It is respectfully submitted that this rejection should be withdrawn for at least the following reasons. As noted above in claim 1, Breslau *et al.* fails to make up for the deficiencies of Goodwin *et al.* as discussed *supra* with regards to the similar limitations recited in independent claim 20, from which the subject claims depend - this rejection should be withdrawn.

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**IX. Rejection of Claim 32 Under 35 U.S.C. §103(a)**

Claim 32 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Breslau *et al.* in view of Nelin, *et al.* It is respectfully submitted that this rejection should be withdrawn for at least the following reasons. Breslau *et al.* and Nelin *et al.* are silent regarding *a third data field having at least one of an administrative flag and a set of information to create an executable image according to a particular user.* Accordingly, this rejection should be withdrawn.

**X. Rejection of Claim 33 Under 35 U.S.C. §103(a)**

Claim 33 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Breslau *et al.* in view of Ramezani (U.S. 6,457,122) and further in view of Spyker *et al.* It is respectfully submitted that this rejection should be withdrawn for at least the following reasons. Breslau *et al.*, Ramezani, and Spyker *et al.*, alone or in combination, do not teach or suggest each and every limitation of applicant's claimed invention. Ramezani fails to make up for the deficiencies of Breslau *et al.*, and Spyker *et al.* as discussed *supra* with regards to similar limitations recited in independent claim 1. The cited art discloses a system for installing programs on writeable storage device in a fault tolerable manner. However, Ramezani is silent regarding *a specialized executable image generated at least in part from the operating environment data, the operating environment data includes at least a set of information to create a specialized executable image according to a particular user* as in the claimed invention. In view of the foregoing, withdrawal of this rejection is respectfully requested.

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CONCLUSION

The present application is believed to be in condition for allowance in view of the above comments and amendments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063 [MSFTP197US].

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicant's undersigned representative at the telephone number below.

Respectfully submitted,

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